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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,705	09/20/2006	Akira Yasuki	960/221	3104
23838 7590 03/20/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
PATEL, VISHAL A				
ART UNIT		PAPER NUMBER		
3676				
MAIL DATE		DELIVERY MODE		
03/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,705

Applicant(s)

YASUKI, AKIRA

Examiner

Vishal Patel

Art Unit

3676

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 9/20/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 recites the limitation "the fluid" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanou et al (JP 63125864A).

Kanou disclose a gasket having a gasket plate made of an electrically insulating material (e.g. 10), the gasket plate having a hole (e.g. hole 9 that corresponds to combustion opening), an annular sealing member (e.g. 14) of a material having a higher heat resistance than the gasket plate, the annular sealing member covers part of the gasket that defines hole (figure 1), the annular sealing member having a pair of holding portions (portions that are on each sides of 10 near the hole 9) that holds the gasket plate in between, a coupler portion (coupler portion 11 that are above 5) that couples the holding portions to each other in the hole, the gasket further comprising a deformation restricting portion (e.g. 13) that restricts deformation of the annular sealing member along the thickness of the gasket plate. The gasket of Kanou can be used as

intended by applicant (e.g. fluid is combustion gas or the gasket is used between block). The annular seal member formed by bending (method limitations given little patentable weight in an apparatus claim) a plate member (the annular seal member is made of plate member). The deformation restricting portion extends along the thickness of the gasket plate between the holding portions (figure 1). The deformation restricting portion has a length that is substantially equal to the thickness of the gasket plate (has a thickness substantially equal to the thickness that is held by the holding portions). The restricting portion is formed by bending (method limitations given little patentable weight in an apparatus claim) part of one of the holding portions toward the other holding portion (for claim 10, the holding portion includes a bend portion 14a and the coupling portion is bent portion 15a). The gasket plate is formed of a single plate member (figure 1).

5. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida (JP 02157629).

Ishida discloses a gasket having a gasket plate made of an electrically insulating material (e.g. 55a and 55b), the gasket plate having a hole (e.g. hole 8 that corresponds to combustion opening), an annular sealing member (e.g. 57 to 59) of a material having a higher heat resistance than the gasket plate, the annular sealing member covers part of the gasket that defines hole (figure 8), the annular sealing member having a pair of holding portions (e.g. portions 57 and 59) that holds the gasket plate in between, a coupler portion (e.g. coupler portion 58) that couples the holding portions to each other in the hole, the gasket further comprising a deformation restricting portion (e.g. 62) that restricts deformation of the annular sealing member along the thickness of the gasket plate. The gasket of Ishida can be used as intended by applicant (e.g. fluid is

combustion gas or the gasket is used between block). The annular seal member formed by bending (method limitations given little patentable weight in an apparatus claim) a plate member (the annular seal member is made of plate member). The deformation restricting portion extends along the thickness of the gasket plate between the holding portions (figure 8). The deformation restricting portion has a length that is substantially equal to the thickness of the gasket plate (has a thickness substantially equal to the thickness that is held by the holding portions). The gasket having a sensor (e.g. 12a or 12b), the gasket plate having a guide hole (figures 1-8) and a lead extending from the sensor passes through the guide hole (figure 8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanou. Kanou discloses the claimed invention except for the insulating material being resin and the heat resistance material being stainless steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the gasket plate be made of resin and the annular sealing member to be made of stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Using the material of resin provides predictable result of high electrical insulation and using stainless steel

provides predictable result of being used in high temperature environment.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. P./
Primary Examiner, Art Unit 3676

/Vishal Patel/
Primary Examiner, Art Unit 3676

